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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,521	10/24/2003	Hideki Iwata	IWATA2	7422
1444	7590	09/03/2004	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,521

Applicant(s)

IWATA ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 21-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and response, filed 6/17/2004, cancelled claims 1-20 and added new claims 21-26. Claims 21-26 are now pending.

Response to Arguments

2. Applicant's arguments with respect to originally-presented claims 1-20 are moot as these claims have been cancelled by the above-mentioned amendment. Grounds of rejection of newly-added, pending claims 21-26 are set-forth below.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 4/5/2004 was filed after the mailing date of the non-final Office action on 3/24/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 21, 22, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 21 and 24, these claims recite “a resin layer composition formed on the impregnated and coated layer.” This limitation lacks support in the originally-filed disclosure, which does not disclose a separate resin layer atop the coated/impregnated sintered layer.

With respect to claims 22 and 25, these claims recite “having a roughness of R_y 1.9 μm or less.” This limitation lacks support in the originally-filed disclosure. While applicant discloses a roughness of 2.0 as an *example* of an undesirable roughness, the broadest disclosed roughness range is 1.0 or less (p. 14 of spec., top).

The examiner has carefully considered the originally-filed disclosure in making the above rejections. Should applicant traverse these rejections, the prosecution history would benefit from an express citation of those page and line number(s) of the spec., which applicant contends support(s) the limitations in question.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims recite the limitation “composed mainly or entirely of.” This limitation renders the claims indefinite.

First, the term “mainly” is a relative term which renders the claim indefinite. The term is not defined in the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how much of the resin

Art Unit: 1762

layer must be thermosetting resin/PTFE in order to be considered “mainly” thermosetting resin/PTFE. 50%? 75%? 95%? Because one of ordinary skill in the art cannot determine, either from applicant’s disclosure or the ordinary meaning of the term, the lower limit encompassed by the term “mainly,” is it impossible to determine the metes and bounds of the claimed subject matter.

Secondly, the term modifies the transitional phrase “composed...of.” The transitional phrase “composed of” has been interpreted in the same manner as either “consisting of” [a closed transitional phrase, excluding all other than the recited elements] or “consisting essentially of,” [a partially closed transitional phrase, that may include certain other elements] depending on the facts of the particular case. See *AFG Industries, Inc. v. Cardinal IG Company*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001) (based on specification and other evidence, “composed of” interpreted in same manner as “consisting essentially of”); *In re Bertsch*, 132 F.2d 1014, 1019-20, 56 USPQ 379, 384 (CCPA 1942) (“Composed of” interpreted in same manner as “consisting of”; however, court further remarked that “the words ‘composed of’ may under certain circumstances be given, in patent law, a broader meaning than ‘consisting of.’ ”). See MPEP 2111.03. It is clear in this case that the transitional phrase “composed...of,” as modified by “mainly or entirely” cannot be considered completely closed. It is impossible to determine, however, what elements may be permissibly included in the partially closed transitional phrase “consisting mainly or entirely essentially of.” Consequently, one of ordinary skill in the art would not be able to determine the metes and bounds of the claimed subject matter.

Allowable Subject Matter

Art Unit: 1762

8. Claims 23 and 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: Applicant has amended the claims to recite a coated and impregnated sintered Cu-alloy. While bearings of such materials are known (see US 3,705,450 A; US 4,000,982 A; and GB 2 174 460 A; for example), there is no suggestion to modify Reising so as to substitute, for the resin-impregnated resin foam composite bearing, the sintered Cu-alloy bearing claimed by applicant.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

Art Unit: 1762

272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 8/30/2004

William P. Fletcher III

Examiner

Art Unit 1762

B. Chen

**BRET CHEN
PRIMARY EXAMINER**